REMARKS

Applicant requests reconsideration and allowance in view of the foregoing remarks. Claims 1-48, and 60 are pending, with claims 1, 15, and 16 being independent.

35 U.S.C. § 112 Rejections

Claims 4, 25, and 38 have been rejected for indefiniteness because the Office Action asserted that it was unclear what the "storage path information" was translated into within the context of the claim. See Office Action, page 3. This rejection does not appear to be properly grounded in 35 U.S.C. § 112, 2nd paragraph. The standard for being indefinite is whether the scope of the claim is ascertainable. The breadth of the claim is not to be equated with indefiniteness. *See* In re Miller, 169 U.S.P.Q. 597, 441 F.2d 689 (C.C.P.A. 1971). *See also* MPEP 2173.04. Applicant believes that the scope of "translating the storage path information" is ascertainable. Because the scope of the claim is believed to be ascertainable, the reversal of the rejection of the claims is requested.

Claim 22 has been rejected for the lack of antecedent basis for a term "a digital image." However, because the term "a digital image" is recited with 'a' for an article rather than with 'the', the claim scope is ascertainable. *See* MPEP 2173.05(e). Therefore, the reversal of the rejection of the claim 22 is requested.

35 U.S.C. § 103(a) Rejections

Claims 1-20, 22-47, and 60 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Stewart (6, 389,460), in view of Lee (6,381,629). This rejection is traversed for the reasons set further below.

Claim 1 recites a method of identifying a storage path used to store digital images within computer systems. A first storage facility and a directory within the first storage facility are identified. Next, two image identifiers are generated: (1) a first image identifier associated with the first storage facility and the directory; and (2) a second image identifier comprising a random number. The first and second image identifiers then are encrypted to generate a unique hash

value. Finally, a storage path is identified using the first and second image identifiers and the unique hash value such that related digital images have unrelated storage paths.

The Office Action acknowledges that "Stewart is silent as to generating a second image identifier comprising a random number." Office Action, page 3. However, the Office Action further contends that one of skill in the art would have been motivated to "incorporate the image identifier associated with a random number" as described in Lee, into the system of Stewart, because it would allow Stewart "to make unique identifiers for each image stored in storage facility." Office Action, page 4.

The Applicant respectfully disagrees with the Office Action. There is no motivation, teaching, or suggestion in either reference to combine Stewart's teachings with Lee. Indeed, the Office Action does not identify any such motivation, teaching, or suggestion, either explicitly or implicitly in the references or in the knowledge generally available to one of ordinary skill in the art, to make such a combination.

Furthermore, notwithstanding the lack of motivation to combine, the combination of Stewart and Lee simply cannot function as suggested by the Office Action. Specifically, Stewart teaches using the same path identifier during the initial storage of the file and the subsequent retrieval of the stored file:

> Thus, for the same image, the same directory path is produced both initially during slot creation as well as subsequently in processing the retrieval of a stored image from the image store. *See* Stewart, Col. 19: 15-17

Fig. 5 (initial storage) and Fig. 7 (subsequent retrieval) illustrate this principle of Stewart. First, during the initial storage, Stewart's system forms "an image identification string by concatenating the url, merged cookies, and authorizations." *See* step 508, Fig. 5. Next, the created image identification string is hashed to form a storage path pointing to a location where a file is eventually stored. *See* steps 510, Fig. 5. If a user desires to access the stored file at some point later in time, Stewart's system performs identical operations to re-create the path to the stored file using the image identification string and the hashing function. *See* steps 706, 708, Fig.7.

Note that the image identification string must remain the same between the time of the initial file storage and the time of the subsequent access. Otherwise, the hashing steps 510 (storage) and 708 will (retrieval) produce different directory paths, and consequently, the user will not be able to access the file (step 714, Fig. 7) using the original directory path (created at step 516, Fig. 5). Stewart explicitly emphasizes this principle:

> In other words, the directory path formed at the end of block 712 of the image retrieval processing 700 should yield the **same** directory path as that produced at the end of the block 514 of the slot creation processing 500 because the same hash function is used. *See* Stewart, Col. 19:10-15 (emphasis added).

However, using Lee's random identifier during the path creation process of Stewart is foreign to the Stewart's principle of "the same directory path." If the random identifier of Lee is added to the Stewart's image identification string, the resulting image identification string will be different every time the user attempts to either store or access the file. Consequently, the hashing function of Stewart will produce different storage paths for every storage or access attempt – hence, the system of Stewart will simply not work because the user will never know exactly where the file has been stored. In fact, it is the constancy of the storage path creation that makes Stewart functional. In Stewart, the user can always access the stored file based a non-changing directory path created during the initial storing of the file. Thus, randomizing the storage path using Lee simply breaks Stewart.

Therefore, the combination of Stewart and Lee is improper and, accordingly, fails to establish a prima facie case of obviousness for independent claims 1, 15, and 16, and the claims that depend from them, for at least this reason. Consequently, the rejections of claims 1, 15, and 16, and the claims that depend from them, should be withdrawn.

Dependent claim 48 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Stewart in view of Lee, and further in view of Mattis (6,209,003). Claim 48 depends on claim 16. For the reasons set above, claim 16 is allowable, and therefore claim 48 is also allowable because it incorporates all of the allowable limitations of claim 16. Consequently, the rejection for claim 48 should be withdrawn.

Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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Thomas Rozylowicz
Reg. No. 50,620

Fish & Richardson P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500
Telephone: (202) 783-5070
Facsimile: (202) 783-2331